

Appl. No. : 10/643,380
Filed : August 19, 2003

REMARKS

Claims 1-8 are pending. The following addresses the substance of the Office Action.

Non-obviousness

The Examiner has rejected Claims 1-8 under 35 USC §103(a) as being allegedly obvious over Hendrikx (EP 1 060 662) in view of Gerhardi (3,405,688).

To establish a *prima facie* case of obviousness a three-prong test must be met. First, there must be some suggestion or motivation, either in the references or in the knowledge generally available among those of ordinary skill in the art, to modify the reference. Second, there must be a reasonable expectation of success found in the prior art. Third, the prior art must reference must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

Here, the cited art either taken alone or in combination, fails to provide the required factors.

As the Applicant argued previously, Hendrikx describes a different kind of a device directed to simultaneous sampling and marking of the ear where the marking and the sampling is performed simultaneously by the same one pin and one accommodating means. In the claimed device, there is one pin for piercing the ear to obtain a tissue sample into the specimen container, and the other pin for placing an ear mark on the ear. Therefore, in the claimed invention, after piercing, the pin used to obtain the tissue sample is removed from the ear, leaving the ear tag attached to the animal by only one pin. Gerhardi describes an ear tag secured to an ear by a plurality of pins to ensure that the tag does not get caught "in bushes, fences and the like". Therefore, the two references teach away from each other, as the Hendrikx device seeks optimization by using one pin for two separate actions, while Gerhardi increases the number of non-removable pins to at least 3 per tag (see col. 2, lines 26-27 and 37-42) for the purpose of secure attachment of the tag to the animal. Therefore, after reading the cited references, a skilled artisan would not be motivated to combine in one ear tag a stationary pin (for securing of the tag to the ear) with a removable pin (for collecting a sample).

For all of the above reasons, Claims 1-8 are non-obvious over the cited references. Applicants respectfully request withdrawal of all rejections under 35 U.S.C. § 103(a), and allowance of the pending application.

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CONCLUSION

Applicants have endeavored to address all of the Examiner's concerns as expressed in the outstanding Office Action. Accordingly, arguments in support of the patentability of the pending claim set are presented above. In light of the above remarks, reconsideration and withdrawal of the outstanding rejections is specifically requested. If the Examiner finds any remaining impediment to the prompt allowance of these claims that could be clarified with a telephone conference, the Examiner is respectfully requested to initiate the same with the undersigned.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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